

REMARKS

In the Office Action dated February 1, 2007, the Examiner objected to Applicant's claim for the benefit of priority under 35 U.S.C. § 119(e); rejected claims 15 and 18-19 under 35 U.S.C. § 112; rejected claims 20-27 under 35 U.S.C. § 102(e) as being anticipated by Martin et al., U.S. Publication No. 2002/0046195 ("Martin"); rejected claims 28-34 and 42 under 35 U.S.C. § 102(e) as being anticipated by Montgomery et al., U.S. Publication No. 2003/0101143 ("Montgomery"); rejected claims 1-6 and 11-17 under 35 U.S.C. § 103(a) as being unpatentable over Martin in view of Sansone et al., U.S. Patent No. 5,019,991 ("Sansone"); rejected claims 7 and 18-19 under 35 U.S.C. § 103(a) as being unpatentable over Sansone in view of Martin; rejected claims 9-10 under 35 U.S.C. § 103(a) as being unpatentable over Manduley et al., U.S. Patent No. 5,324,893 ("Manduley") in view of Sansone; rejected claim 35 under 35 U.S.C. § 103(a) as being unpatentable over Montgomery; and rejected claims 36-41 and 43-44 under 35 U.S.C. § 103(a) as being unpatentable over Montgomery in view of Sansone. By this Amendment, Applicants have cancelled claims 3, 4, 9, 10, 29, and 32, and amended claims 1, 5, 7, 9, 11, 15, 18, 20, 28, 30, and 33-36. Claims 1-2, 5-8, 11-28, 30-31, and 33-44 are currently pending.

Priority

In the Office Action, the Examiner stated that the "disclosure of the prior-filed application, Application No. 60/399,251, fails to provide adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. 112 for one or more claims of this application." However, this is not correct. Moreover, the Examiner did not identify any specific claims for which support was allegedly missing. Applicants

respectfully request the Examiner to either identify the claims allegedly lacking support in the priority application, or withdraw the objection to Applicants' claims for priority.

The Office Action contains the above statement and a number of other statements reflecting characterizations of the specification, related art, and claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

Claim Rejections Under 35 U.S.C. § 112, Second Paragraph

The Examiner rejected claim 15 as having "insufficient antecedent basis for" the "limitation 'the machine readable format.'" Office Action, p. 2. Applicants have amended claim 15 to recite "[t]he system of claim 14, wherein the postage indicia is a bar code," and accordingly, Applicants respectfully request that the Examiner withdraw this rejection.

The Examiner also rejected claims 18-19 as "unclear." By this amendment, Applicants have corrected the informalities noted in Examiner's rejection of claim 18. Applicants respectfully submit that this amendment correcting the informalities does not narrow the scope of the claims and is not for reasons related to patentability. Accordingly, Applicants respectfully request that the Examiner withdraw the rejection of claims 18-19.

Claim Rejections Under 35 U.S.C. § 102

The Examiner rejected claims 20-27 under 35 U.S.C. § 102(e) as being anticipated by Martin. To anticipate a claim, the reference must teach every element of the claim. M.P.E.P. § 2131 (8th ed. 2001, 5th revision August 2006). Because Martin

does not disclose each and every element recited in the claim, the rejection under 35 U.S.C. § 102(e) is improper and should be withdrawn.

For example, claim 20 recites a combination including, among other things, “printing a postage label including a postage amount represented only in an electronically readable format and a verification information allowing a mailing system to subsequently adjust the mailing amount.” Martin does not disclose “printing a postage label including ... verification information” Instead, Martin “shows an example of four printed stamps on a label sheet 400.” (Martin, ¶ 0051, Fig. 4.)

The Examiner suggests that Martin does not disclose verification information, and instead “interprets the postage amount of the mailing label to be verification information.” Office Action, p. 4. Although the Examiner is entitled to interpret the claims terms broadly, such interpretation cannot be unreasonable. Indeed, M.P.E.P. § 2111 indicates that “pending claims must be given their broadest reasonable interpretation consistent with the specification.” While the Examiner may not be required to “interpret claims in applications in the same manner as a court would interpret claims in an infringement suit,” the Examiner is required to apply “to verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in applicant’s specification.” M.P.E.P. § 2111. Accordingly, the broadest reasonable interpretation of the terms “postage amount” and “verification information” of claim 20 must be consistent with the interpretation of the phrases that those skilled in the art would reach. See id. Further, all of the words in a

claim “must be considered in judging the patentability of that claim against the prior art.”
In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

Here, the Examiner incorrectly asserts that “the postage amount of the mailing label” of Martin corresponds to the claimed “verification information.” These assertions are not consistent with the interpretation of the distinct terms “postage amount” and “verification information” as is known in the art and in the context of Applicants’ specification and claims. The Examiner ignores reasonable interpretations of two distinct claim terms, in the context of not only the specification, but the known meaning in the art, by interpreting the two distinct terms in claim 20 (i.e., “postage amount” and “verification information”) as having the same meaning. Doing so violates at least the policies governed by the M.P.E.P. and fails to support the rejection of claims 20-27 in view of the cited art.

Because Martin does not disclose every element of claim 20, it cannot anticipate the claim, and Applicants request the reconsideration and withdrawal of the section 102 rejection of claim 20. In addition, dependent claims 21-27 are allowable at least by reason of depending from claim 20.

Applicants respectfully traverse the rejection of claims 28-32 and 42 under 35 U.S.C. § 102(e) as being anticipated by Montgomery. By this Amendment, Applicants have cancelled claims 19 and 32, rendering the rejection of those claims moot. Further, Montgomery does not teach each and every element recited in any of claims 28, 30-31, and 42, as required to support a proper rejection under 35 U.S.C. § 102(e). M.P.E.P. § 2131.

Claim 28 recites a combination including “an electronic interface for transmitting the postage indicia to a user, wherein the electronic interface is in communication with the database such that, upon purchase of the postage indicia by the sender, the database is updated with a record for the new postage indicia.” Montgomery does not disclose this element. Instead, as the Examiner notes, Montgomery discloses “storing each tracking ID that has been issued to an end user computer 308 and the postage information associated with each tracking ID...” (Montgomery, ¶ 0110.) In Montgomery, each tracking ID is stored after a tracking ID “has been issued to an end user computer,” rather than “upon purchase of the postage indicia by the sender,” as recited in claim 28.

Because Montgomery does not disclose every element of claim 28, it cannot anticipate the claim, and Applicants request the reconsideration and withdrawal of the section 102 rejection of claim 28. In addition, dependent claims 30-31 and 33-35 are allowable at least by reason of depending from claim 28.

Claim 42 recites a combination including “receiving an estimated weight for a parcel from a sender via a web page.” Montgomery does not disclose this element. The Examiner appears to agree that Montgomery does not disclose “receiving an estimated weight for a parcel.” However, the Examiner “interprets barcode 206 to include the estimated weight for a parcel.” Office Action, p. 8. First, this interpretation is not consistent with the meaning of the term “receiving an estimated weight” as is known in the art and in the context of Applicants’ specification and claims. By way of background, Applicants respectfully direct the Examiner to paragraph 022 of the

Applicants' specification, which states: "the sender may make his or her best guess as to the weight of the parcel."

Further, even assuming the Examiner's characterization of Montgomery's "barcode 206 to include the estimated weight for a parcel" is correct, which Applicants do not concede, Montgomery still fails to disclose "receiving an estimated weight for a parcel from a sender via a web page," as recited in claim 42. Montgomery's "barcode 206" is not received "from a sender" or "via a web page." Instead, Montgomery merely discloses that "label 200 shown in Fig. 2 carries a self-validating unique postage indicium 204 that is presented in a two-dimensional barcode 206" (Montgomery, ¶ 0088.) Because Montgomery does not disclose every element of claim 42, it cannot anticipate the claim, and Applicants request the reconsideration and withdrawal of the section 102 rejection of claim 42.

Claim Rejections Under 35 U.S.C. § 103

By this Amendment, Applicants have cancelled claims 3-4 and 9-10, rendering the rejection of those claims moot. Applicants respectfully traverse the rejection of claims 1-2, 5-6, and 11-17 under 35 U.S.C. §103 as being obvious from Martin in view of Sansone. A *prima facie* case of obviousness has not been established.

To establish a *prima facie* case of obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See M.P.E.P. § 2142. Moreover, "in formulating a rejection under 35 U.S.C. § 103(a) based upon a combination of prior art elements, it remains necessary to identify the reason why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed." USPTO Memorandum from Margaret A. Focarino, Deputy

Commissioner for Patent Operations, May 3, 2007, page 2. “[T]he analysis supporting a rejection ... should be made explicit” and it is “important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements in the manner claimed.” *Id.* (citing *KSR Int’l Co. v. Teleflex, Inc.*, No. 04-1350 (U.S. Apr. 30, 2007)). A *prima facie* case of obviousness has not been established because, among other things, neither Martin nor Sansone, nor their combination, teaches or suggests each and every feature of Applicants’ claims.

Amended claim 1 calls for a combination including, for example, “printing the digital signature, the postage amount, the addressee information, the sender information, and the date on a postage indicia in a bar code format.” Martin fails to teach or suggest “printing the digital signature, the postage amount, the addressee information, the sender information, and the date on a postage indicia in a bar code format,” as recited in claim 1. Although Martin’s Figure 4 shows a “data matrix 432, which includes a digital signature,” Martin does not disclose “printing the digital signature, the postage amount, the addressee information, the sender information, and the date on a postage indicia *in a bar code format*,” as recited in claim 1 (emphasis added).

The Examiner cited Sansone as a teaching of “affixing to a mailpiece a postage indicia,” “mailing the mailpiece,” and “paying an adjusted postage amount.” Office Action, p. 9. Even assuming the Examiner’s characterization of Sansone is correct, which Applicants do not concede, Sansone fails to cure the deficiencies of Martin, discussed above. That is, Sansone, also, fails to teach or suggest “printing the digital signature, the postage amount, the addressee information, the sender information, and

the date on a postage indicia *in a bar code format*,” as recited in claim 1 (emphasis added). The cited references, taken either alone or in any reasonable combination, thus fail to teach or suggest all the limitations of claim 1. For at least this reason, Martin and Sansone therefore fail to support a *prima facie* case of obviousness. The rejection of claim 1, and dependent claims 2 and 5-6, under 35 U.S.C. §103 as being obvious from Martin in view of Sansone is thus improper and should be withdrawn.

Applicants respectfully traverse the rejection of claims 11-17 under 35 U.S.C. §103 as being obvious from Martin in view of Sansone. A *prima facie* case of obviousness has not been established because among other things, neither Martin nor Sansone, nor their combination, teaches or suggests each and every feature of Applicants’ claims.

Amended claim 11 calls for a combination including, for example, “means for outputting a postage indicia comprising a stealth postage for the amount prepaid.” Martin fails to teach or suggest “means for outputting a postage indicia comprising a stealth postage for the amount prepaid,” as recited in claim 11. Although Martin’s Figure 4 includes a “postage amount ‘\$0.34’ 424,” Martin does not disclose “a stealth postage,” as recited in claim 1 (emphasis added). As described in paragraph 028 of page 7 of Applicants’ specification, “the printed postage indicia will take the form of a ‘stealth postage’ indicia 200, that is, the postage indicia will include the postage information represented only in machine readable format such as a two dimensional bar code....”

Although the Examiner is entitled to interpret the claims terms broadly, such interpretation cannot be unreasonable. Indeed, M.P.E.P. § 2111 indicates that “pending

claims must be given their broadest reasonable interpretation *consistent with the specification.*” Accordingly, the broadest reasonable interpretation of the “stealth postage” of claim 11 must be consistent with the interpretation of the phrases that those skilled in the art would reach. The Examiner’s reading of Martin’s “postage amount \$0.34” is inconsistent with the interpretation of the term “stealth postage” as is known in the art and in the context of Applicants’ specification.

The Examiner characterized Sansone as a teaching of “means for paying for an adjusted amount of postage subsequent to the mailing of the mailpiece.” Office Action, p. 12. Even assuming the Examiner’s characterization of Sansone is correct, which Applicants do not concede, Sansone fails to cure the deficiencies of Martin, discussed above. That is, Sansone, also, fails to teach or suggest “means for outputting a postage indicia comprising a stealth postage for the amount prepaid,” as recited in claim 11. The cited references, taken either alone or in any reasonable combination, thus fail to teach or suggest all the limitations of claim 11. For at least this reason, Martin and Sansone therefore fail to support a *prima facie* case of obviousness. The rejection of claim 11, and dependent claims 12-17, under 35 U.S.C. §103 as being obvious from Martin in view of Sansone is thus improper and should be withdrawn.

Applicants respectfully traverse the rejection of claims 7-8 and 18-19 under 35 U.S.C. §103 as being obvious from Sansone in view of Martin. A *prima facie* case of obviousness has not been established because, among other things, neither Sansone nor Martin, nor their combination, teaches or suggests each and every feature of Applicants’ claims.

Amended claim 7 calls for a combination including, for example, “updating a database to associate the billing information with the unique postage number.” Sansone fails to teach or suggest this element. Instead, Sansone merely states that “[i]f the postage was not correct, then in block 1012 the descending registers are appropriately debited to reflect the correct postage.” (Sansone, 5:15-18). The Examiner characterized Martin as a teaching of “the initial postage amount in only a machine readable format.” Office Action, p. 14. Even assuming the Examiner’s characterization of Martin is correct, which Applicants do not concede, Martin fails to cure the deficiencies of Sansone, discussed above. That is, Martin, also, fails to teach or suggest “updating a database to associate the billing information with the unique postage number,” as recited in amended claim 7. The cited references, taken either alone or in any reasonable combination, thus fail to teach or suggest all the limitations of claim 7. For at least this reason, Sansone and Martin therefore fail to support a *prima facie* case of obviousness.

Independent claim 18, although different in scope from claim 7, contains recitations similar to that of claim 7. Therefore, neither Sansone nor Martin teach or suggest, at least, the element of claim 7 recited above. The rejection of independent claims 7 and 18, and dependent claims 8 and 19 under 35 U.S.C. §103 as being obvious from Sansone in view of Martin is thus improper and should be withdrawn.

Applicants respectfully traverse the rejection of claim 35 under 35 U.S.C. §103 as being obvious from Montgomery. Amended claim 35 depends from independent claim 28, and therefore contains all the recitations of claim 28. As discussed above, claim 28 recites a combination including “an electronic interface for transmitting the postage

indicia to a user, wherein the electronic interface is in communication with the database such that, upon purchase of the postage indicia by the sender, the database is updated with a record for the new postage indicia.” Montgomery does not disclose this element. Accordingly, the rejection of claim 35 under 35 U.S.C. §103 as being obvious from Montgomery is thus improper and should be withdrawn.

Applicants respectfully traverse the rejection of claims 36-41 and 43-44 under 35 U.S.C. §103 as being obvious from Montgomery in view of Sansone. A *prima facie* case of obviousness has not been established because among other things, neither Montgomery nor Sansone, nor their combination, teaches or suggests each and every feature of Applicants’ claims.

Amended claim 36 calls for a combination including, for example, “a billing interface in communication with the scanner and the scale for verifying that the postage paid is the proper amount, and, if not, transmitting a bill to a sender of the mailpiece for an adjusted amount and receiving payment for the adjusted amount.” As the Examiner suggested, Montgomery fails to teach or suggest this element. Moreover, Sansone fails to cure Montgomery’s deficiencies.

The Examiner characterized Sansone as a teaching of “verifying that the postage paid is the proper amount, and, if not, receiving payment for an adjusted amount.” Office Action, p. 19. Even assuming the Examiner’s characterization of Sansone is correct, which Applicants do not concede, Sansone fails to cure the deficiencies of Montgomery, discussed above. That is, Sansone, also, fails to teach or suggest “a billing interface in communication with the scanner and the scale for verifying that the postage paid is the proper amount, and, if not, transmitting a bill to a sender of the

mailpiece for an adjusted amount and receiving payment for the adjusted amount,” as recited in amended claim 36. The cited references, taken either alone or in any reasonable combination, thus fail to teach or suggest all the limitations of claim 36. For at least this reason, Montgomery and Sansone therefore fail to support a *prima facie* case of obviousness. The rejection of independent claim 36, and dependent claims 37-41 under 35 U.S.C. §103 as being obvious from Manduley in view of Sansone is thus improper and should be withdrawn.

Claims 43 and 44 depend from allowable claim 42, and therefore include all the recitations of claim 42. As discussed above, claim 42 recites a combination including “receiving an estimated weight for a parcel from a sender via a web page,” and Montgomery does not disclose this element. Sansone fails to cure the deficiencies of Montgomery, as Sansone merely discloses a standalone “system for certifying correctly accounted postage payment.” (Sansone, Abstract). For at least the reason that the prior art fails to teach each and every element of claims 43 and 44, no *prima facie* case of obviousness has been established. Accordingly, the rejection of claims 43 and 44 under 35 U.S.C. §103 as being obvious from Montgomery is thus improper and should be withdrawn.

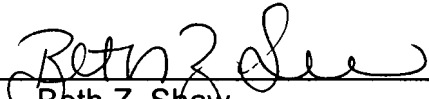
In view of the foregoing amendments and remarks, Applicants respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
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Dated: July 31, 2007

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